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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,169	08/16/2001	Sunghoon Kim	058333-0106	1098

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EXAMINER

BORIN, MICHAEL L

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,169

Applicant(s)

KIM ET AL.

Examiner

Michael Borin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Status of Claims

Claims 1,4,5 are pending. Claims 1,4,5 are amended.

Response to restriction requirement filed 10/21/2003 is acknowledged. Applicant elected, with traverse, Group I, claim 1. Examiner disagrees with applicant's statement that claims 4,5 are dependent claims - these claims are independent claims drawn to separate methods of use of the product of claim 1. As to the rejoinder of the claims, if a product claim 1 is found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. (MPEP 821.04). The restriction requirement is still deemed proper and is therefore made FINAL. Claims 4,5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected groups.

Claim 1 is currently under examination.

Claim Rejections - 35 USC § 102 and 103.

Claim 1 is rejected under 35 U.S.C. 102(b) as clearly anticipated by Kao et al. (J. Biol. Chem., 269,25106-25119, 1994; sequence alignment from Database

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SwissProt AC Q12904 is attached to the reference). The reference teaches human EMAP II (see Fig. 1) which is identical to instant SEQ ID No. 1.

The reference teaches the peptide that meets the structural limitation claimed. Although the reference does not teach the functional limitation of the peptide, such a limitation would be inherent in the peptide since it meets the structural limitations of the claim. A reference which is silent about a claimed invention's feature is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. In re Oelrich, 212, USPQ 323 (CCPA 1981). Where the claimed and prior art products are identical or substantially identical in structure or composition, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Claim 1 is rejected under 35 U.S.C. 102(e) as clearly anticipated by WO 00/73801 (filing date 05/26/2000; publication date 12/07/2000). The reference teaches peptide SEQ ID No. 606 which comprises peptide of instant SEQ ID No. 1 at positions 17-163. See p. 208 of the reference and sequence alignment attached.

The reference teaches the peptide that meets the structural limitation claimed. Although the reference does not teach the functional limitation of the peptide, such a limitation would be inherent in the peptide since it meets the structural limitations

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of the claim. A reference which is silent about a claimed invention's feature is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. In re Oelrich, 212, USPQ 323 (CCPA 1981). Where the claimed and prior art products are identical or substantially identical in structure or composition, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Further, even if the translation is provided, the international filing date of the reference is more than 1 year earlier than the foreign priority date of the instant application.

Conclusion.

No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

January 9, 2004

mlb

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Michael Borin', with a long, sweeping horizontal stroke extending to the right.